

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLARENCE D. CHANG, SCOTT HAN,
ROGER A. MORRISON and JOSE G. SANTIESTEBAN

Appeal 96-0460
Application 08/150,303¹

ON BRIEF

Before: McKELVEY, Senior Administrative Patent Judge, and
SCHAFFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

¹ Application for patent filed 12 November 1993. The application on appeal is said to be a continuation-in-part of application 08/095,884, filed 22 July 1993. Another application (08/679,238), said to be a continuation of application 08/095,884, issued on 17 February 1998 as U.S. Patent 5,719,097. The real party in interest would appear to be either Mobil Research and Development Corporation or Mobil Oil Corporation.

The appeal is from a decision of the Primary Examiner rejecting claims 1-22. We reverse.

A. Findings of fact

The record supports the following findings by a preponderance of the evidence.

1. Claims 1-22 are on appeal.

2. Claim 1, which is believed to be representative of the claims on appeal, reads as follows (paragraph numbering, bold and indentation added):

A process for hydrocracking naphtha, said process comprising contacting a naphtha feed with a hydrocracking catalyst under sufficient hydrocracking conditions, said hydrocracking catalyst comprising

(1) a hydrogenation/dehydrogenation catalytic component and

(2) an acidic solid catalytic component comprising **a Group IVB metal oxide modified with an oxyanion of a Group VIB metal.**

3. According to the specification (page 4, lines 24-30; bold added):

[T]he expression, **Group IVB metal oxide modified with an oxyanion of a Group VIB metal**, is intended to connote a material comprising, by elemental analysis, a Group IVB

metal, a Group VIB metal and oxygen, with more acidity than a simple mixture of separately formed Group IVB metal oxide mixed with a separately formed Group VIB metal oxide or oxyanion.

4. The examiner has rejected claims 1-22 as being unpatentable under 35 U.S.C. § 103 over Michelson, U.S. Patent 3,755,147 (1973).²

5. In the appeal brief (Paper 16, page 3), applicants make the following argument:

The Group VIB metal on a zirconia carrier of Michelson cannot possibly read on a Group IVB metal oxide modified with an oxyanion of a Group VIB metal, as claimed ***. As pointed out in the *** specification on page 4 ***, the Group IVB metal oxide modified with an oxyanion of a Group VIB metal is defined as being a material which has more acidity than a single mixture of separately formed Group IVB metal oxide mixed with a separately formed Group VIB metal oxide or oxyanion.

6. In setting out the rejection under 35 U.S.C. § 103, the examiner has not told us why the subject matter of the claims, as a whole, would have been obvious taking into

² Michelson is prior art under 35 U.S.C. § 102(b).

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consideration the limitation of claim 1 set out in bold in Finding 2, supra.

7. In the Examiner's Answer, we have been unable to find a response to applicants' argument set out in Finding 5, supra, and we have not found any discussion addressing the limitation of claim 1 set out in bold in Finding 2, supra.

B. Discussion

1. Scope and meaning of claim 1

A specification may define terms used in a claim. When the definition of "**a Group IVB metal oxide modified with an oxyanion of a Group VIB metal**" set out in the specification is given weight, as it should, then the scope and meaning of claim 1 becomes the following:

A process for hydrocracking naphtha, said process comprising contacting a naphtha feed with a hydrocracking catalyst under sufficient hydrocracking conditions, said hydrocracking catalyst comprising

(1) a hydrogenation/dehydrogenation catalytic component and

(2) an acidic solid catalytic component comprising **a Group IVB metal oxide modified with an oxyanion of a Group VIB metal**, which is a material comprising,

(a) by elemental analysis, a Group IVB metal, a Group VIB metal and oxygen,

(b) with more acidity than a simple mixture of separately formed Group IVB metal oxide mixed with a separately formed Group VIB metal oxide or oxyanion.

2. Resolution on the merits

In many respects the state of affairs with respect to this appeal is probably symptomatic of one of the reasons why the board has such an unacceptable backlog of ex parte appeals pending before it at the present time.

The examiner does not appear to have determined the precise scope of claim 1. Likewise, it appears to us, that the examiner has simply declined to address the limitation set out in bold in claim 1, supra--a limitation which appears in all claims on appeal. We find the examiner's action in declining to determine the scope of claim 1 and/or address the limitation set out in bold, supra, to be curious given that applicants discuss, and rely on, the limitation on page 4 of their appeal brief. We decline to search the prior art relied upon by the examiner to see if somehow that prior art might meet the limitation relied upon by the examiner. Because the examiner fails to make out a prima facie case due to a failure to address a limitation relied upon by the applicants, we reverse.

3. Other observations about the record

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We will also note that the applicants have caused considerable confusion on the record and therefore have not been of much assistance in certain respects.

Applicants rely on two declarations in an effort to overcome the examiner's rejections. Both declarations make reference to Example 1 of the specification. There is no Example 1 in the specification. Furthermore, there is a reference on page 7, lines 11-12 of the specification to "Examples recited hereinafter, especially in Examples 16-25 ***." We have not been able to find Examples 16-25 in the specification. We are concerned that neither the examiner nor applicants carefully read the specification. We also are concerned as to whether the declarants or the examiner carefully read the two declarations.

Since the declarations mention Example 1 of the specification and there is no Example 1 in the specification, in reaching our decision, we decline to give any weight to the declarations. We leave it to applicants and the examiner to

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look into the matter of the reference to Examples 16-25 when prosecution is resumed before the examiner.³

C. Decision

The decision of the examiner rejecting claims 1-22 as being unpatentable under 35 U.S.C. § 103 over Michelson is reversed.

REVERSED.

	_____)	
	FRED E. McKELVEY, Senior)	
	Administrative Patent Judge)	
)	
)	
	_____)	
PATENT	RICHARD E. SCHAFER)	BOARD OF
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	_____)	
	JAMESON LEE)	
	Administrative Patent Judge)	

³ We note that applicants' related U.S. Patent 5,719,097, supra n.1, contains Examples 1 through 38.

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